

adapted to effect selection of one of the choices identified by the cursor. Support for this amendment can be found in claims 24 and 29. Limitations regarding a finger switch has been removed from claim 23.

Claim 24 has amended to remove the language added to claim 23. Claim 25 has been amended to highlight that the thumb switch plate selectively and independently contacts each electrical contact upon sufficient movement. Claim 38 has been amended in a somewhat similar fashion. Claim 25 has also been amended to clarify that the electrical contacts are fixed relative to the thumb base plate. Further, Claim 38 has also been amended to remove the language that the electrical contacts are fixed relative to the body. Support for these amendments can be found in original Figures 3A-3C. Claim 26 has been amended to depend from new claim 39 and to provide that the finger switch is adapted to perform multiple functions. Support for this amendment can be found on page 7, lines 15-22, page 19, lines 10-31 and Figures 4A-4C.

New claim 39 has been added by this amendment. Support for claim 39 can be found in claim 23.

No new matter is believed to have been added by this amendment.

Reconsideration of the rejected claims and consideration of the new claim is respectfully requested in view of the above-recited amendments and the arguments set forth below.

Interview Summary

On October 5, 1999, the undersigned Attorney for the Applicant forwarded a draft

response to the Examiner, John Tweel. Subsequently, on October 6, 1999, the Examiner telephoned the Applicant's Attorney and provided that the draft response appeared to put the application in condition for allowance. However, a final determination regarding allowability could not be made until a formal response was filed. The Applicant wishes to thank the Examiner for his time and assistance in the prosecution of this matter.

Rejections Under 35 U.S.C. § 103

Claim 23 is rejected under 35 U.S.C. § 103(a) as being anticipated by Paley (U.S. 2,396,871) in view of Will. Claims 24, 25, 27, 37, and 38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Paley in view of Will and further in view of Miyakawa (U.S. 4,931,781). Claim 26 was rejected under 35 U.S.C. § 103 as being unpatentable over Paley in view of Will and further in view of Ebina et al. (U.S. Patent No. 4,812,829). Applicant respectfully submits that Claims 23-28, 38, and 39 are patentable.

Paley relates to a remote control which includes three, single function on/off type switches. One of the switches is designed to be engaged by the thumb, one by the index finger and one by the remaining fingers. The mouse includes means, mounted in the housing, for locating the mouse with respect to at least one spatial dimension and orientational dimension. (Column 2, Lines 7-18) Will relates to a control for a digital watch including thumbwheel and a button. See Abstract.

In distinction to Paley and Will, amended Claim 23 recites that the "thumb switch includes a center switch and an annular switch which surrounds the center switch, the annular switch being adapted to operate independently from the center switch; wherein the annular switch is adapted to effect movement of the cursor between the plurality of

choices and the center switch is adapted to effect selection of one of the choices identified by the cursor...".

Because Paley and Will lack teaching of a thumb switch which includes a center switch and an annular switch which surrounds the center switch, the annular switch being adapted to operate independently from the center switch; the annular switch effecting movement of the cursor between the plurality of choices and the center switch effecting selection of one of the choices identified by the cursor, the 35 U.S.C. § 103 rejection based upon Paley and Will is believed to be overcome.

Further, a potential 35 U.S.C. § 103 rejection based on Paley, Will, and Miyakawa (U.S. 4,931,781) is believed to be inappropriate. The Applicant submits that there is no teaching or suggestion in Miyakawa, Paley, and Will for the combination as now claimed. Claim 23 recites that the "thumb switch includes a center switch and an annular switch which surrounds the center switch, the annular switch being adapted to operate independently from the center switch; wherein the annular switch is adapted to effect movement of the cursor between the plurality of choices and the center switch is adapted to effect selection of one of the choices identified by the cursor...". This feature allows the user to depress the annular switch to move the cursor and subsequently depress the center switch to effect the selection without removing the thumb from the switches.

In contrast, Miyakawa, the switching device illustrated in Figures 20A-20C is circular instead of annular. Stated another way, Miyakawa discloses a switch which uses a circular key top 306 which slides and makes contacts with a plurality of spherical balls 309 and plate spring contacts 310.

The Applicant submits that the structure which would result from the proposed combination does not meet the terms of Claim 23. In particular, assuming the references can be combined, the resulting combination would result in switches which are adjacent each other. The circular switch of Miyakawa would not allow for it to encircle the switch of Paley. Further, the thumb wheel of Will would not allow for it to encircle the switch of Paley. Instead, assuming that Paley can be combined with Miyakawa and/or Will, the resulting switches would have to be adjacent each other. Thus, the user would have to remove the finger from one switch to maneuver the other switch. Accordingly, the user would have to remove the finger from one switch to maneuver the other switch. Thus, the structure which would result from the combination of Miyakawa, Paley, and Will does not meet the terms of claim 23.

In summary, the Applicant submits that the only teaching or suggestion to modify and combine the references to meet the terms of claim 23 can be found in the present application. It is improper to use the Applicant's patent as an instruction book to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 810 F2d 1561 (Fed. Cir. 1987). Accordingly, claim 23 is considered patentable.

Because Claims 24-28, 38, and 39 depend directly or indirectly on Claim 23, they are likewise patentably distinguishable.

Further, a number of the dependent claims are considered to be independently patentable. For example, Claim 25 requires that at least one of the quadrant switches includes a plurality of spaced apart electrical contacts and a thumb switch plate which is adapted to move relative to thumb base plate, wherein the thumb switch plate selectively and independently contacts each of the electrical contacts upon sufficient movement of

the thumb switch plate relative to the thumb base plate.

None of the cited references teach or suggest this feature. Accordingly, Claim 25 is considered to be independently patentable.

Conclusion

In conclusion, Applicant respectfully asserts that Claims 23-36, 38, and 39 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 619-688-1300 for any reason that would advance the instant application to issue.

Dated this 6th day of October, 1999.

Respectfully submitted,



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